

App. No. 10/036,919
Atty. Docket No. 10122A
Amdt. dated December 18, 2003
Reply to Office Action of October 21, 2003

REMARKS/ARGUMENTS

Applicant appreciates the courtesies extended by Examiner Chen during a telephonic interview with Applicant's attorney, Dean Simmons, on December 11, 2003. In that interview, the Objections and Rejections set forth in the October 21, 2003 Office Action were discussed. In particular, support for the claim language with respect to ratios of modulus, elongation to break, and tensile strength were discussed.

The basis for the rejections under 35 USC § 112 and § 103 is that the disclosure of transverse dimension and machine dimension values for modulus, elongation to break, and tensile strength does not support claim recitals to "ratios" of these values. In other words, the Office Action asserts that because the Specification does not expressly calculate the ratios of the transverse dimension and machine dimension values, claim recitals of these ratios is not supported by the Specification.

It is well established that a patent application need not describe the claimed subject matter in exactly the same terms as used in the claims. All that is necessary is that the application simply indicates to those skilled in the art that as of the filing date of the application, the applicant had invented what is claimed. *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995). In other words, the failure of a specification to specifically mention a limitation that appears in the claims is not an inadequate disclosure when one skilled in the art would recognize upon reading the specification that the claim reflects what the specification shows has been invented. *See, Crown Operations International, Ltd. V. Solutia, Inc.*, 289 F.3d 1367, 1376 (Fed. Cir. 2002).

With respect to the ratios recited in the pending claims, a remarkably similar factual scenario was addressed in *Ex Party Harvey*, 3 USPQ 2d 1626, 1627-28 (Bd. Pat. App. & Int'f. 1987). The application considered by the Board in *Harvey* related to high temperature refractory walls constructed from plastic blocks. The specification stated that a block dimension "in one particular application" was "5-7/8" high, 8-7/8" wide and 17" long" and that "actual dimensions may vary depending upon the specific application and temperature requirements". The claim recital at issue was to a block having a size ratio of "approximately 3:1.5:1". In rejecting the claims, it was asserted that since the specification language did not describe the claimed ratio,

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the application did not support claim limitations to the ratios of the dimensions set forth in the specification. A closely analogous situation exists in the present Application. For example, with respect to modulus ratios, the data tables of the Application set forth a wide range of modulus values measured in the machine and transverse directions. The ratios of the transverse direction to machine direction values range from about 1.5 to about 2. The claimed ratios of elongation to break and tensile strength are also established by the transverse direction and machine direction values set forth in the data tables of the Specification. Therefore, as with the *Harvey* application, one skilled in the art, by reviewing the Application, would be able to determine that films having the recited ratios of properties were invented by the Applicant. Therefore, Applicant is entitled to set forth these ratios in the pending claims because they are clearly supported by the Specification.

With respect to the particulars of the Section 103 Rejection, all claim recitals are supported by the parent application as filed. Accordingly, Applicant is entitled to a priority date corresponding to the filing date of the parent application for all claims. This being the case, the PCT publication of the parent application is not prior art against any pending claims.

Reconsideration of claims 20-37 is earnestly solicited.

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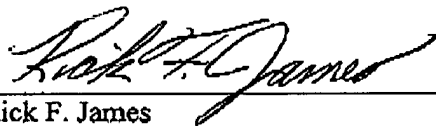
Conclusion

In light of the foregoing, it is believed that all pending claims (20-37) are in condition for allowance. An early Notice of Allowance is respectfully requested.

Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number indicated below so that all matters may be expeditiously resolved.

Respectfully submitted,

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